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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,116	08/25/2003	Kevin RJB Donovan	16113-0633001	9849
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FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3688	PAPER NUMBER
			NOTIFICATION DATE 05/18/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[PATDOCTC@fr.com](mailto:PATDOCTC@fr.com)

<b>Office Action Summary</b>	<b>Application No.</b> 10/647,116	<b>Applicant(s)</b> DONOVAN ET AL.
	<b>Examiner</b> Raquel Alvarez	<b>Art Unit</b> 3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 April 2010.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10,12-21,31-69 and 71-73 is/are pending in the application.

4a) Of the above claim(s) 19-21 and 31-65 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10,12-18,66-69 and 71-73 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This office action is in response to communication filed on 4/5/2010.
2. Claims 1-10, 12-21, 31-69 and 71-73 are pending on this application. Claims 19-21 and 31-65 are withdrawn. Claims 1-10, 12-18, 66-69 and 71-73 are presented for examination.

#### **Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10, 71-73 recites "providing an electronic document including a link to the network **without** providing the advertisement image" the claims recite what is excluded rather than what is included.

Correction is required.

#### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-10, 12-18, 66-69 and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay (WO 00/38074 hereinafter) in view of Subramanian al. (2002/0123912 hereinafter Subramanian).

With respect to claims 1, 9, 68, Kay teaches a computerized system for generating an advertisement grouping comprising a first plurality of advertisements based on advertisement rankings associated with the first plurality of advertisements (i.e. determining view-ups based on bids)(Figure 1);

storing the advertisement in association with a network-based locator as being an up-to-date advertisement grouping for a specific distribution subject (see 16A);

generating a modified advertisement comprising a second plurality of advertisements if the advertisement rankings change as compared to the advertisement rankings on which the generation of the advertisement was based (i.e. as new view-up advertisement become available, the system compares the new view-up to other bids in order to select the highest bids)(see Figure 3A and page 16, lines 2-5);

storing the modified advertisement in association with the network-based locator as being the up-to-date advertisement for the specific distribution subject; receiving a request for an advertisement associated with the network-based locator; and in response to receiving the request, transmitting the up-to-date advertisement grouping stored in association with the network-based locator (see Figure 3B).

With respect to the limitation, the image receiving means for receiving a request for the advertisement image associated with the network-based locator for inclusion in an electronic document and advertisement image generation including ranking means for generating advertisements ranking/ re-ranking and storing the highest ranked advertisements and the modified advertisements image (i.e. Kay teaches inserting the new ads images for inclusion on the website, based on the ranking and storing the

advertisement image in order for later display)(see Figures 3A, 3B and page 16, lines 2-5).

With respect to the newly amended feature, Subramanian teaches the electronic document being presented to the user upon receiving indication of the user accessing the electronic document, wherein the advertisement image or the modified image is presented in the electronic document being displayed for the user (Subramanian teaches on paragraph [0113] "In use the contextual advertisement and the contextual affiliate link software and hardware provides an infrastructure that provides contextual presentation of the advertisements and links. As an example, if Hewlett-Packard ("HP") is the Service Provider 16 which is using contextual advertisement, HP will define the rules for when its advertisement should be shown. If HP defines a rule that targets the selling of HP printers with Compaq computers, then when a user looks at a page with Compaq computers, the appropriate HP advertisement 128 will be shown as illustrated in FIG. 12. In another example, assume that Barnes and Noble is the Service Provider who has and affiliate program and CNET signs up to be Barnes and Noble's affiliate site. Then Barnes and Noble can defines a rule that an affiliate link for books on "PC Computers" should be shown when a user is looking at Dell computers. As a result, when a user looks for Dell computers at CNET, IF the appropriate advertisement and affiliate link 130 for Barnes and Noble is shown as illustrated in FIG. 13"). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Kay the teachings of Subramanian of the electronic document being presented to the user upon receiving indication of the user accessing

the electronic document, wherein the advertisement image or the modified image is presented in the electronic document being displayed for the user in order “**to allow users to focus on what they want, allow service providers to focus on what they offer, and alleviate the effort currently required on both sides to find each other”** ((Subramanian, paragraph 0003).

With respect to claims 2, 4, 6-8, Kay further teaches a bid representing an amount to be paid for click-throughs by end-user recipients to target site associated with the advertisement (i.e. advertisers entering a “bid” which is the amount of money that the advertisers pay when a user clicks on their listing)(page 12, lines 18-24 and page 14, lines 5-7).

With respect to claims 3, 5 Kay further teaches grouping advertisements based on the highest revenue efficiency (page 14, lines 9-20).

Claims 10-18, 71-73 further recite providing an electronic document including a link to the network based locator without providing the advertisement image. Subramanian teaches providing affiliate link 130 and the user having to click on the link in order to open the advertisement image. It would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to have included recite providing an electronic document including a link to the network based locator without

providing the advertisement image because such a modification would redirect the surfer to another web page without revealing the content of the link.

With respect to claims 66-67, Kay further teaches the advertisements are identified in corresponding portions of the graphical image by an HTML image map (see page 7, lines 22-24).

Claim 69 further recites that the electronic document is an email. Official Notice is taken that it old and well known for electronic documents to be in the form of e-mail in order to allow recipients to view the electronic information when they please. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the electronic document being email in order to obtain the above mentioned advantage.

**Response to Arguments**

7. Applicant's arguments with respect to claims 1-10, 12-18, 66-69 and 71-73 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571)272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

Raquel Alvarez  
Primary Examiner  
Art Unit 3688

R.A.  
5/11/2010